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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/665,955
Filing Date: September 17, 2003
Appellant(s): TODD ET AL.

George D. Morgan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 21, 2008 appealing from the Office action mailed September 24, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,279,626	CUNNINGHAM	01-1994

Declaration of Edward R. Eaton, filed October 16, 2006.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7, 19, 55 and their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rejected because the terms "comprehensive fuel additive" is not understood. In the original claims, appellant recited a user-friendly effective additive. Appellant deleted those terms and replaced them with "comprehensive fuel additive." The examiner has reviewed the specification and finds that any recitation regarding a comprehensive fuel additive refers to the combination of all of the claimed components and not to an individual component.

3. Claims 15, 31, 36-38,40-43 and 46-53 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claim 15 contains the trademark/trade names DCI 6A; DMA 558; and AO 22. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218

USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a corrosion inhibitor, a detergent, a fuel stabilizing additive and a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 31 contains the trademark/trade names T9312; DCI 6A; AROL 50; DMA 558 and OLI 5015. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide, a corrosion inhibitor, a water managing additive; a detergent; a solvent; a fuel stabilizer and a lubricity enhancer and, accordingly, the identification/description is indefinite.

Claims 36 and 46 contain the trademark/trade name DCI products, HITEC 580, BIOBOR JF and ONDEO-NALCO 5403. Where a trademark or trade name is used in a

claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe corrosion inhibitors and, accordingly, the identification/description is indefinite.

Claim 37 contains the trademark/trade name DMA 451. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe water managing additive and, accordingly, the identification/description is indefinite.

Claim 38 contains the trademark/trade name DMA products. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112,

second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a detergent and, accordingly, the identification/description is indefinite.

Claim 40 contains the trademark/trade name AO 22 and AO series. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fuel stabilizer and, accordingly, the identification/description is indefinite.

Claim 41 contains the trademark/trade name ONDEO-NALCO 303MC; and BIOBOR JF. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade

name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide and, accordingly, the identification/description is indefinite.

Claim 42 contains the trademark/trade name DCI products and ONDEO-NALCO 5403. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 43 contains the trademark/trade name HITEC 3023. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to

identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a combustion modifier and, accordingly, the identification/description is indefinite.

Claim 47 contains trademarks/trade names for components a-e. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe water managing additive and, accordingly, the identification/description is indefinite.

Claim 48 contains the trademarks/trade names for components a)-i). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is

used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe a detergent and, accordingly, the identification/description is indefinite.

Claim 49 contains the trademark/trade name AROL 50 and HISOL 100. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a solvent and, accordingly, the identification/description is indefinite.

Claim 50 contains the trademark/trade name DMA 558 AND DMA SERIES PRODUCTS. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods

associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fuel stabilizer and, accordingly, the identification/description is indefinite.

Claim 51 contains the trademarks/trade names for components a), b), and d)-f) Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide and, accordingly, the identification/description is indefinite.

Claim 52 contains trademarks/trade names for components a)-g). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

trade name. In the present case, the trademark/trade name is used to identify/describe a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 53 contains the trademark/trade name HITEC 3023 and ALKEN EVEN FLO 910. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a combustion modifier and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-14, 19-30, 35, 37-42, 44, 45, 47-52 and 54-60 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 5,279,626).

Cunningham teaches a method for enhancing a fuel additive package so as to improve the shelf-life of the package wherein the package comprises a detergent/dispersant (appellant's fuel stabilizer/detergent), a demulsifier (appellant's water managing action additive) and admixing a solvent stabilizer composition (satisfies appellant's biocide, combustion boosting additive, water managing additive, solvent and low temperature flow improver) (see abstract). The solvent stabilizer is formed from at least one aromatic hydrocarbon solvent and at least one alkyl or cycloalkyl alcohol. Examples of the aromatic solvent include benzene and alkyl substituted benzene or mixtures thereof. Examples of the alcohol solvents include C_2-C_8 alcohols such as ethanol, propanol and mixtures thereof (see col. 2, lines 17-38). The detergent/dispersant is the reaction product of a polyamine and at least one acyclic hydrocarbyl-substituted succinic acylating agent (see col. 3, lines 40-43). The demulsifier includes compounds such as organic sulfonates, polyoxyalkylene glycols (see col. 5, lines 54-57). Other components may be used in the additive package including oxidation inhibitors, corrosion inhibitors, emission control additives (combustion modifying additive), lubricity additives, biocides and octane or cetane improves (combustion boosting additives) (see col. 5, lines 64-68). Cunningham teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Cunningham differs from the claims in that he does not specifically teach a composition wherein all the components are present. However, no unobviousness is seen in this difference because Cunningham teaches all of the

claimed components and he teaches that they may be combined to produce an additive package.

In the second aspect, Cunningham differs from the claims in that he does not specifically teach the claimed proportions. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have optimized the proportions of the additive components through routine experimentation for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(10) Response to Argument

Appellant argues that the term "comprehensive fuel additive" is clearly defined in the specification and that claims 1, 7, 19 and 55 are not indefinite.

The examiner has reviewed Appellant's specification and notes the definition which Appellant has set forth. However, the last component of the claims, component (i), is set forth as a separate component. Therefore, the examiner maintains that any recitation regarding a comprehensive fuel additive refers to the combination of all claimed components (a-h) and not to an individual component.

Appellant argues that the usage of trademarked fuel additives in claims 15, 31, 36-38, 40-43 and 46-53 is definite and that it is known that fuel additives do not change formulation without also always changing the formulation name. Appellant has provided a declaration submitted by Edward Eaton to support his position.

The declaration has been considered but is not found persuasive. As stated in the prior office action, the MPEP is very specific regarding the use of a trademark or tradename in a claim. If, as Appellant is arguing, the trademark or tradename is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph.

Appellant argues that the claimed invention solves a longstanding problem and is patentable. Appellant argues that Cunningham teaches a fuel additive package that has a stable shelf life and is directed to a completely different problem than what Appellant solves. Appellant argues that the examiner's position regarding optimizing the proportions of the additive components through routine experimentation is flawed because the present invention does not involve a result effective variable. Appellant argues that there is no recognition in the prior art of any fuel additive being used in a comprehensive single addition transportation fuel additive and that Cunningham merely provides a recipe for enhancing the shelf-life of one particular type of detergent additive. Appellant argues that Cunningham fails to suggest the quantities or formulas for the other components that may be used in the additive package.

Cunningham teaches a fuel additive package wherein those fuel additives of the present invention may be present. While Cunningham is concerned with improving the

shelf-life of the additive package, this in no way teaches away from the fact that Appellant's additives may be present in the additive package of Cunningham. Appellant states that he has solved a longstanding problem. However, it appears that all Appellant has done is taken conventional fuel additives and prepared a concentrate of those additives. Cunningham clearly teaches that it is known to do this very same thing, albeit for a reason different from that of Appellant. There is nothing in the present specification that shows that the claimed additive system produces unexpected results. The skilled artisan recognizes that the dilution ratios of the additives will be different depending upon the climate wherein the fuel is prepared, the type of fuel, and other physical parameters. Therefore, the examiner fails to understand how Appellant has solved a longstanding problem by combining conventional additives to form a concentrate of these conventional additives.

With respect to Appellant's argument that the present invention does not involve a result effective variable, the examiner respectfully disagrees. In the claims, Appellant states that each component (a-i) is present in an amount sufficient to effectively enhance the fuel. Clearly, the claimed components are result effective variables.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

//Cephia D. Toomer//

Cephia D. Toomer

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